

ESTTA Tracking number: **ESTTA774838**

Filing date: **10/05/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Google Inc.
Granted to Date of previous extension	10/05/2016
Address	1600 Amphitheatre Parkway Mountain View, CA 94043 UNITED STATES

Correspondence information	Dori Ann Hanswirth Hogan Lovells US LLP 875 Third Ave New York, NY 10022 UNITED STATES dori.hanswirth@hoganlovells.com, boxip@hoganlovells.com, theresa.house@hoganlovells.com Phone:(212) 918-3000
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### Applicant Information

Application No	86693187	Publication date	06/07/2016
Opposition Filing Date	10/05/2016	Opposition Period Ends	10/05/2016
Applicant	Asia Ad Alliance Limited Room 1408 14/7 Tak Shing House, Hong Kong, HONG KONG		


### Goods/Services Affected by Opposition

Class 042. First Use: 2013/06/01 First Use In Commerce: 2013/06/01 All goods and services in the class are opposed, namely: Providing temporary use of non-downloadable software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Providing temporary use of non-downloadable software to enable sharing of multimedia content and comments among users; Providing temporary use of non-downloadable software to enable content providers to track multimedia content; Providing temporary use of non-downloadable analytics software, namely, software that provides statistics about the behavior of viewers of online videos, movies, pictures, images, text, photos, games and other user-generated content; Hosting on-line web facilities for others for conducting interactive discussions and sharing on-line content; Hosting multimedia entertainment and educational content for others; Providing a web site that gives computer users the ability to upload and share user-generated videos, essays and articles on a wide variety of topics and subjects
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3711233	Application Date	10/29/2008
Registration Date	11/17/2009	Foreign Priority Date	NONE
Word Mark	YOUTUBE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2008/01/24 First Use In Commerce: 2008/01/24 Downloadable software to enable uploading, posting, showing, displaying, tagging, [blogging,] sharing and otherwise providing electronic media or information over the Internet and other communications networks; application program interface (API) that enables developers to integrate video content and functionality into websites, software applications, and devices</p> <p>Class 035. First use: First Use: 2006/03/15 First Use In Commerce: 2006/03/15 Advertising and promotional services on behalf of others; promotional services, namely, promoting the goods and services of others through online entertainment, online education, and sharing of multimedia content via the Internet and other communications networks; developing and providing marketing programs for advertisers, marketers, and content providers; providing a website where advertisers, marketers, and content providers can reach, engage, and interact with online users for the purposes of promotion or advertising</p> <p>Class 038. First use: First Use: 2005/04/24 First Use In Commerce: 2005/04/24 Audio, video and multimedia broadcasting via the Internet and other communications networks; webcasting services; transmission of messages, data and content via the Internet and other communications networks; providing forums and [chat rooms] for the transmission of messages, comments and multimedia content among users in the field of general interest via the Internet and other communications networks; transmission of electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet and other communications networks; providing community forums for users to post, search, watch, share, critique, rate, and comment on, videos and other multimedia content via the Internet and other communications networks</p> <p>Class 041. First use: First Use: 2005/04/24 First Use In Commerce: 2005/04/24 Entertainment and educational services, namely, providing a website featuring user-generated content, namely, electronic media, multimedia content, videos, movies, pictures, images, text, photos, audio content, and related information via the Internet and other communications networks on a wide variety of topics and subjects; Providing online journals, namely, blogs featuring information on the subject of the above-listed user-generated website content; Online digital video, audio and multimedia entertainment publishing services; Online digital publishing services; Entertainment services, namely, conducting contests</p>		

	<p>Class 042. First use: First Use: 2005/04/24 First Use In Commerce: 2005/04/24</p> <p>Providing temporary use of non-downloadable software to enable uploading, capturing, posting, showing, editing, playing, streaming, viewing, previewing, displaying, tagging, [ blogging,] sharing, manipulating, distributing, publishing, reproducing, and otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content and information via the Internet and othercommunications networks; Providing temporary use of non-downloadable software to enable sharing of multimedia content and comments among users; Providing temporary use of non-downloadable software toenable content providers to track multimedia content; Providing temporary use of non-downloadable analytics software, namely, software that provides statisticsabout the behavior of viewers of onlinevideos, movies, pictures, images, text,photos, games and other user-generated content; Hosting of websites featuring multimedia content for others; Hosting multimedia entertainment and educational content for others; Providing a web site that gives computer users the ability toupload and share user-generated videos,[ essays and articles ] on a wide variety of topics and subjects</p>
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Attachments	<p>77603268#TMSN.png( bytes )</p> <p>6696865_2.pdf(157616 bytes )</p>
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Dori Ann Hanswirth/
Name	Dori Ann Hanswirth
Date	10/05/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 86/693,187

For Mark: MASS TUBER

Published in the Official Gazette: June 7, 2016

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GOOGLE INC.,	:	
	:	Opposition No. _____
Opposer,	:	
	:	
v.	:	
	:	<b><u>NOTICE OF OPPOSITION</u></b>
ASIA AD ALLIANCE LIMITED,	:	
Applicant.	:	
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Commissioner for Trademarks  
Attn: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Google Inc. (“Google” or “Opposer”), a Delaware corporation with offices at 1600 Amphitheatre Parkway, Mountain View, California, 94043, believes it will be damaged by registration of the standard character word mark MASS TUBER (the “MASS TUBER Mark”) for the goods and services in International Class 42 as shown in Application Serial No. 86/693,187 (the “Application”), and having been granted an extension of time to oppose up to and including October 5, 2016, hereby opposes the same.

As grounds for opposition, Google alleges that:

**Opposer and Its YOUTUBE Marks**

1. In 1998, Google introduced breakthrough technology enabling users to search and organize the vast quantities of information available on the internet. Eighteen years later,

www.google.com remains one of the world's most popular search engines, and Google itself has become a leading technology company offering a wide variety of products and services.

2. Among its array of innovative products and services, Google offers a video sharing service under the famous mark, YOUTUBE (the "YOUTUBE Mark"). YouTube, Inc. launched the Youtube.com website on April 24, 2005, and the mark has been in continuous use ever since. Google acquired YouTube, Inc. in November 2006, and thereafter maintained YouTube, Inc.'s rights and use of YOUTUBE.

3. YOUTUBE is a coined term. The YOUTUBE Mark embodies the substantial and valuable reputation and goodwill that Google has earned in the marketplace for its high-quality software services and products. Google's YOUTUBE is one of the most famous and well-known software brands in the world, and it has been so for years. Indeed, at the time Google acquired YouTube in 2006, it was already an extremely popular product. In August 2006, the Wall Street Journal published an article stating that the YouTube website hosted approximately 6.1 million videos and had about 500,000 user accounts. In November 2007, Comscore reported that YouTube users watched 2.9 billion videos and Nielsen Netratings reported that the service had 67.5 million unique users. Today, Youtube.com is the leading online video sharing site and the sixth top Internet destination, also according to Nielsen Netratings. Alexa, a web traffic ranking company, also lists Youtube.com as the second most-popular website both in the United States and globally. YouTube has over a billion users, and on a daily basis people watch millions of hours on YouTube and generate billions of views.

4. The YOUTUBE brand has been the subject of thousands of unsolicited stories in the news media, including in newspapers, magazines, and on television. As a result of Google's

widespread use of its YOUTUBE Mark in the United States and worldwide, continuous and extensive media coverage, as well as the high degree of consumer recognition of the YOUTUBE Mark, and the strong and loyal base of YOUTUBE users, among other factors, the YOUTUBE Mark is famous.

5. Google is the owner of several U.S. trademark registrations relating to its famous YOUTUBE brand. It owns U.S. trademark Registration No. 3,711,233, registered on November 17, 2009, for the inherently distinctive YOUTUBE Mark, in standard character form. This registration, which is based on a date of first use in International Class 42 on April 24, 2005, covers “Providing temporary use of non-downloadable software to enable uploading, capturing, posting, showing, editing, playing, streaming, viewing, previewing, displaying, tagging, [ blogging,] sharing, manipulating, distributing, publishing, reproducing, and otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, user-generated content, audio content and information via the Internet and other communications networks; Providing temporary use of non-downloadable software to enable sharing of multimedia content and comments among users; Providing temporary use of non-downloadable software to enable content providers to track multimedia content; Providing temporary use of non-downloadable analytics software, namely, software that provides statistics about the behavior of viewers of online videos, movies, pictures, images, text, photos, games and other user-generated content; Hosting of websites featuring multimedia content for others; Hosting multimedia entertainment and educational content for others; Providing a web site that gives computer users the ability to upload and share user-generated videos, [ essays and articles ] on a wide variety of topics and subjects” (the “YOUTUBE Registration”). Google also owns

registrations for additional YOUTUBE marks in International Class 42 for similar services under Registration Nos. 3,714,120; 3,525,802; and 3,525,803.

**Applicant and Its Confusingly Similar MASS TUBER Mark**

6. On July 15, 2015, Applicant Asia Ad Alliance Limited (“Applicant”) filed a use-based application to register MASS TUBER pursuant to 15 U.S.C. § 1051(a), claiming first use of the mark on June 1, 2013.

7. The Application seeks registration of the MASS TUBER Mark for the following goods and services: “Providing temporary use of non-downloadable software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Providing temporary use of non-downloadable software to enable sharing of multimedia content and comments among users; Providing temporary use of non-downloadable software to enable content providers to track multimedia content; Providing temporary use of non-downloadable analytics software, namely, software that provides statistics about the behavior of viewers of online videos, movies, pictures, images, text, photos, games and other user-generated content; Hosting on-line web facilities for others for conducting interactive discussions and sharing on-line content; Hosting multimedia entertainment and educational content for others; Providing a web site that gives computer users the ability to upload and share user-generated videos, essays and articles on a wide variety of topics and subjects” in International Class 42.

8. On information and belief, Applicant had knowledge of Google’s YOUTUBE Mark prior to filing and selected the MASS TUBER Mark with knowledge and intent to trade off of Google’s famous YOUTUBE Mark. Additionally, Applicant has taken action designed to

falsely indicate affiliation of its MASS TUBER goods and services with Google, such as advertising its services on YouTube.com and using a logo (visible in the specimen of use Applicant filed on July 15, 2015 and in advertisements/social media) that appropriates the same red lozenge design famously used on YOUTUBE products (see below comparison):



9. The marks are similar as to appearance, sound, and meaning. Applicant's MASS TUBER Mark utilizes the entire TUBE formative of Google's YOUTUBE, replacing the three-letter YOU-prefix with a four-letter MASS prefix, resulting in similar appearance and sound. Accordingly, the marks convey a similar commercial impression.

10. Applicant's description of goods and services overlaps almost identically with Google's. Indeed, Applicant's MASS TUBER tracks the language in Google's YOUTUBE Registration nearly verbatim. Here are the MASS TUBER services, with the language that overlaps with Google's YOUTUBE Mark, Reg. No. 3,711,233, for International Class 42 in underline, red, and bold: "**Providing temporary use of non-downloadable software** for the collection, **editing**, organizing, modifying, book marking, transmission, storage and **sharing** of data and **information**; **Providing temporary use of non-downloadable software to enable sharing of multimedia content and comments among users**; **Providing temporary use of non-downloadable software to enable content providers to track multimedia content**; **Providing temporary use of non-downloadable analytics software, namely, software that provides statistics about the behavior of viewers of online videos, movies, pictures, images, text, photos, games and other user-generated content**; **Hosting** on-line **web** facilities **for**



others for conducting interactive discussions and sharing on-line content; Hosting multimedia entertainment and educational content for others; Providing a web site that gives computer users the ability to upload and share user-generated videos, essays and articles on a wide variety of topics and subjects.”

11. Furthermore, Applicant’s software product is designed to be used in connection with Google’s YOUTUBE-branded software.

12. For all of these reasons, consumers would be likely to believe that Applicant’s software emanates from the same source as the software that Google offers under the YOUTUBE brand.

13. All of the above is likely to suggest to consumers that the MASS TUBER Mark identifies a Google or Google-endorsed product, when that is not so. Google is not the source of Applicant’s intended goods, nor has Google endorsed or sponsored Applicant or its goods.

**Applicant Admits That Its MASS TUBER Mark Is Confusingly Similar**

14. Applicant’s MASS TUBER Mark was published in the Official Gazette on June 7, 2016.

15. On July 6, 2016, Google obtained an extension of time to oppose the Application until and including October 5, 2016.

16. On August 23, 2016, Google contacted counsel of record for Applicant by letter to explain Google’s objections to the Application.

17. On September 7, 2016, Applicant’s counsel informed Google that their firm was withdrawing as attorneys for the Application, and referred Google’s counsel to contact Applicant directly.

18. That same day, the owner of Applicant contacted counsel for Google by email, in which he stated, “I'm the owner of MassTuber.com. I am in receipt of a letter regarding our trademark. I do see the similarities and would hate to confuse anyone. I will be renaming the product shortly. I apologize for any inconvenience this has caused.”

19. On September 12, 2016, Google asked Applicant to confirm when the Application would be withdrawn. Applicant did not respond.

20. On September 28, 2016, Google contacted Applicant again to inquire whether Applicant had taken steps to withdraw the Application. Google also requested consent for an additional extension of time to file the instant Opposition, so that Applicant could have time to make good on his promise to cease using the MASS TUBER name. Applicant again did not respond.

21. No withdrawal of the Application appears on the United States Patent and Trademark Office website at this time. Google is therefore forced to file the instant proceeding to protect its trademark rights and to encourage Applicant to follow through on its promise to re-name its service.

**FIRST GROUND FOR OPPOSITION:  
LIKELIHOOD OF CONFUSION**

22. Google incorporates by reference Paragraphs 1 through 21, inclusive, as if fully set forth herein.

23. Google began using its YOUTUBE Mark in commerce at least as early as April 24, 2005 and filed an application for the YOUTUBE Mark resulting in a federal registration issued in November 17, 2009, prior to Applicant's July 15, 2015 filing date and claimed first-use date of June 1, 2013. Accordingly, Google has both priority of use and of registration over

Applicant for the YOUTUBE Mark, and its rights in the YOUTUBE Mark precede any rights Applicant may have in the MASS TUBER Mark.

24. Google's YOUTUBE Mark is strong and famous.

25. The MASS TUBER Mark is similar in sight, sound, meaning, and commercial impression to the YOUTUBE Mark.

26. The services covered by the Application are the same as, or are highly related to, the services that Google offers in connection with its YOUTUBE Mark.

27. Applicant's goods and services are offered through the same or substantially similar channels of trade and to the same or substantially similar classes of consumers as the services that Google offers in connection with its YOUTUBE Mark.

28. Applicant's MASS TUBER Mark and its commercial impression suggest an affiliation or connection between Applicant and Google where none exists. This connection is further deepened by Applicant's use of a stylized version of its logo that is strikingly similar to Google's YouTube Logo (see below comparison):



29. Google is not affiliated or connected with Applicant or its services, nor has Google endorsed or sponsored Applicant or its services.

30. Registration of Applicant's MASS TUBER Mark is likely to cause confusion among the relevant consuming public and will likely cause the relevant consuming public to mistakenly conclude that Applicant's services are associated with Google, when they are not.

31. Registration of Applicant's Mark will damage Google because Applicant's Mark is likely, when used on or in connection with the applied-for goods, to cause confusion or to cause mistake or to deceive and because registration would be inconsistent with the trademark rights of Opposer. Thus, Applicant's Mark is unregistrable under 15 U.S.C. §§ 1052, 1063, and 1125 and should be refused registration.

**SECOND GROUND FOR OPPOSITION:  
DILUTION OF A FAMOUS MARK**

32. Google incorporates by reference Paragraphs 1 through 21 inclusive, as if fully set forth herein.

33. The YOUTUBE Mark is inherently distinctive in relation to the goods and services with which Google uses its YOUTUBE Mark.

34. Google enjoys substantially exclusive use of the YOUTUBE Mark throughout the United States and internationally.

35. Google has broadly promoted the YOUTUBE Mark, and Google's products and services offered under the YOUTUBE Mark have enjoyed extensive media attention.

36. As a result of the enormous publicity afforded the YOUTUBE Mark, and the strong and loyal base of customers that enjoy Google's goods and services, the YOUTUBE Mark has a high degree of consumer recognition, is widely recognized by the general consuming public of the United States as a designation of Google's goods and services, and is famous.

37. The YOUTUBE Mark became famous before Applicant's filing date of July 15, 2015.

38. The MASS TUBER Mark is likely to dilute the famous YOUTUBE Mark.

39. The MASS TUBER Mark is substantially similar to the YOUTUBE Mark, and, in fact, wholly incorporates the entire -TUBE portion of Google's famous mark. As a result, its use is likely to cause an association between Applicant's MASS TUBER Mark and the YOUTUBE Mark that impairs the distinctiveness of the YOUTUBE Mark and weakens the connection in the public's mind between the YOUTUBE Mark and Google's goods and services.

40. Upon information and belief, Applicant intended to create an association with Google's famous YOUTUBE Mark. This association is further deepened by Applicant's use of a stylized version of its logo that is strikingly similar to Google's YouTube Logo (see below comparison):



41. Accordingly, Applicant's MASS TUBER Mark is unregistrable under 15 U.S.C. §§ 1052, 1063, and 1125, and should be refused registration.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained, and the registration of the mark MASS TUBER as shown by Application Serial No. 86/693,187 be refused.

Dated: New York, New York

October 5, 2016

Respectfully submitted,

HOGAN LOVELLS US LLP

Attorneys for Opposer

By: /s/ Dori Ann Hanswirth /

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**Certificate of Service**

I, Dori Ann Hanswirth, hereby certify that on October 5, 2016, I served a true and correct copy of the foregoing Notice of Opposition via first-class mail and by overnight courier on Applicant at the address shown below:

Asia Ad Alliance Limited  
Theatre Lane 20 Des Voeux Rd, Central Hk  
Room 1408 14/7 Tak Shing House,  
Hong Kong HONG KONG

/s Dori Ann Hanswirth /  
Dori Ann Hanswirth